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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,068	10/27/2003	Donald W. Howie	0103-0035(ZM0476)	3820
43231	7590	10/17/2005	EXAMINER	
ZIMMER TECHNOLOGY - REEVES			SNOW, BRUCE EDWARD	
P. O. BOX 1268			ART UNIT	
ALEDO, TX 76008			PAPER NUMBER	
			3738	
DATE MAILED: 10/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,068

Applicant(s)

HOWIE ET AL.

Examiner

Bruce E. Snow

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5-15,17,18 and 22-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-14 is/are allowed.
- 6) ☒ Claim(s) 3,5,6,15,17,18,22,24,27,28 and 32-34 is/are rejected.
- 7) ☒ Claim(s) 7-10,23,25,26,29-31 and 35-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's amendments and arguments filed 9/27/05, have been fully considered.

Regarding claim 15 rejected in view of Mathys, Sr. et al, the Examiner's notes that the combination of the positioner and hip implant is not being claimed. The screw of Mathys is fully capable of fulfilling the functional language on a hip implant wherein the borehole is unthreaded (such as Lazzeri et al (5,163,964)).

Regarding the rejection in view of Carpenter et al, this reference was not applied to claim 3 previously because of the cured cement mantel limitation which has since been deleted.

Applicant's amendments and arguments overcame the rejection in view of Link et al.

Regarding the rejection in view of Spotorno et al, the Examiner's position is explained in the grounds of rejection.

Allowable Subject Matter

Claims 11-14 are allowed over the art of record.

Claims 7-10, 23, 25, 26, 29-31, 35-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Mathys, Sr. et al.

Mathys, Sr. et al teaches a positioner for implantation adjacent a femoral hip implant for retaining the femoral hip implant in a femoral canal having a canal wall, the positioner comprising:

means for preventing the femoral hip implant from rising out of the femoral canal beyond a predetermined position while permitting subsidence of the femoral hip implant down into the femoral canal (retension member, first member), see screw head; and means for anchoring the means for preventing relative to the femoral canal (anchor member, second member), see screw 9.

Regarding at least claim 15, the screw head extends in a direction perpendicular to the second member 9.

Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Carpenter et al (5,425,768).

Carpenter et al teaches a positioner for implantation adjacent a femoral hip implant for retaining the femoral hip implant in a femoral canal having a canal wall, the positioner comprising:

means for preventing the femoral hip implant from rising out of the femoral canal beyond a predetermined position while permitting subsidence of the femoral hip implant down into the femoral canal Including elements 46 which couples to the stem 22 of the femoral hip implant; and

means for anchoring the means for preventing relative to the femoral canal 62 which are capable of being wedged in the femoral canal providing anchoring and further provide a "means for anchoring" once the cement cures.

Claims 3, 15, 18, 22, 24, 27, 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Spotorno et al (2002/005266).

Spotorno et al teaches first member 8, 7 extending over the implant which limits upward movement of the implant and permits downward axial movement; and a second member 6 extending at an angle from the first member for anchoring.

Regarding claim 22, "L" shaped, multiple elements 7 all form an L shape with element 6. All legs 7 extend "over" the exterior of the implant and portions extend proximal the shoulder of the implant.

Regarding claim 3, the embodiment shown in figure 2 would allow for a head. Note that element 8 is an "clamping apparatus" around the stem.

Regarding claim 15, see the embodiment shown in figures 3-6 which include cap 12 which is proximally over the hip implant.

Regarding claim 18, see the embodiment shown in figure 2 which is capable of "during articulation of the joint". This embodiment allows blocks upward motion and permits down motion of the implant as the positioner moves with the implant. Additionally, "articulation of the joint" is not limited to a head articulating with the acetabulum, therefore, also see the embodiment shown in figured 3-6.

Claim 22, clearly elements 6 and 7 are "L" shaped; figure 3 clearly shows leg 7 is "relative" to the longitudinal axis or any other axis.

Claims 3, 5-6, 15, 17, 27, 28, 32, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Burke et al (5,702,485).

Referring to at least figure 14, Burke et al teaches a positioner for implantation adjacent a femoral hip implant 14 for retaining the femoral hip implant in a femoral canal having a canal wall, the positioner comprising:

means for preventing the femoral hip implant from rising out of the femoral canal beyond a predetermined position while permitting subsidence of the femoral hip implant down into the femoral canal Including elements 98; and

means for anchoring the means for preventing relative to the femoral canal including element 106.

Regarding claim 17, see first member 96; second member 94; third member 104; tab 106; boss 98.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bes

A handwritten signature in black ink, appearing to be 'BSN', with a long horizontal flourish extending to the right.

BRUCE SNOW
PRIMARY EXAMINER